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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09 719,731	09 20 2001	Christoph Schmitz	R00099US	4113

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EXAMINER

KEEHAN, CHRISTOPHER M

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 11 06 2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/719.731

Examiner

Christopher M. Keehan

Applicant(s)

SCHMITZ ET AL

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.134(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 September 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.8 6) ☐ Other

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## DETAILED ACTION

### *Drawings*

The drawings are objected to because of the following informalities: Figures 1 and 2 do not notate **run** time, as described in the Specification, but rather just time. One looking at these figures would not readily understand them; Figures 4-7 should have the axes labeled as there is no indication in these figures what is being shown. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-11 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. On page 3, the last paragraph of the specification, Applicant states "One-component does not, however, mean that the solution may not contain more than one type of **polyoxisiloxane** polymer, optionally also in admixture with chemically different polymers (e.g. polyacrylates). It is not clear what a **polyoxisiloxane** polymer is, and the specification does not enable one skilled in the art

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to ascertain the meaning of **polyoxisiloxane** polymer. Further, on page 3 of the specification, fourth full paragraph, Applicant states, "Furthermore, these prior art polymers are one-component polymer solutions." It is not clear, but based on the disclosure, it may be that Applicant means that the prior art polymers are **not** one-component polymers.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 2 is are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 2 recites the limitation "wherein the metal additive" in claim 1. There is insufficient antecedent basis for this limitation in the claim. Claim 1 only claims a complex of a metal ion, and it is not clear by the claim language in claim 2 if the amount of the metal additive is based on the complex of the metal ion or just the elemental metal.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the

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treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or  
(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

Claims 1-11 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Sherman et al. (6,407,195 B2). Regarding claims 1, 4, 7, 8, Sherman et al. disclose a process for the production of polysiloxane pressure-sensitive adhesive (PSA) layers by means of coating and drying a one-component polysiloxane PSA solution onto a suitable flat-shaped carrier (col. 19, line 49-col.20, line 30), a complex of a metal ion of the group as instantly claimed, with a low-molecular organic complex former, more specifically titanium acetylacetonate, added to the organic adhesive solution to be coated (col.14, lines 35-47), and heating and/or drying of the adhesive (col.23, lines 14-18). Sherman et al. also appear to inherently disclose whereby the metal ion is only released from the bond to the complex former under the conditions of heating and/or drying, and the organic complex former is substantially removed during drying. Because the process of Applicant is the same as Sherman, it is inherently disclosed that the same reaction would have occurred. Similar processes can reasonably be expected to yield products which inherently have the same properties. *In re Spada* 15 USPQ 2d 1655 (CAFC 1990); *In re DeBlauwe* 222 USPQ 191; *In re Wiegand* 86 USPQ 155 (CCPA 195). If not inherent, then it would have been obvious to one of ordinary skill in the art at the time the invention was made for the metal ion to be released from the bond to the complex former under the conditions of heating and/or drying because the process and materials of Sherman et al.

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are at least similar to that of Applicant's, and at least similar materials in the same process would have been expected to yield at least similar results.

Regarding claims 2 and 3, Sherman et al. disclose an amount of additive of up to about 10 percent by weight (col.13, lines 41-46), which encompasses the instantly claimed range.

Regarding claim 5, Sherman et al. disclose wherein the drying is carried out at a temperature of between 20 and 120°C (col.23, lines 14-18).

Regarding claim 6, Sherman et al. disclose the same materials and the same process of Applicant (as set forth above for claim 1). The same reasoning applies to claim 4 as set forth in claim 1. Sherman et al. disclose an adhesive thickness of 38 $\mu$ m (col.23, lines 14-18), which, when coated having the same materials as Applicant, would yield a weight per unit area that is inherently included in the instantly claimed range of between 10 and 300 g/m<sup>2</sup>.

Regarding claim 9, Sherman et al. disclose wherein the polysiloxane is substantially polydimethyl siloxane (col.21, line 17-col.22, line 67).

Regarding claim 10, Sherman et al. disclose wherein the free silanol

Regarding claim 11, Sherman et al. disclose a medicinal patch having a layered structure, the structure having at least one layer of a polysiloxane PSA produced by the means as claimed in claim 1 (col.19, lines 49-60).

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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher M. Keehan whose telephone number is (703) 305-2778. The examiner can normally be reached on Monday-Friday, from 6:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert A. Dawson can be reached on 308-2340. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Christopher Keehan 11/16/02

October 24, 2002